

PATENT

Atty Docket No.: 700110076-1

App. Ser. No.: 10/045,418

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks. Claims 1-11 are pending in the present application, of which Claim 1 is independent. Claims 9-10 have been amended. Claims 12-16 previously were cancelled without prejudice or disclaimer of the subject matter contained therein.

No new matter has been introduced by way of the amendments and entry thereof is respectfully requested.

Claims 9 and 10 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

Claims 1-3, 5, 7-11 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Niwa (U.S. 6,853,777).

Claims 1-11 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gifford (U.S. 6,049,785) in view of The Bank Credit Card Business ("BCCB book") by the American Bankers Association.

Claims 1-3 and 6 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Watanabe (U.S. 6,098,055).

Drawings

It is noted with appreciation that the formal drawings filed on April 27, 2005 are accepted.

PATENT

Atty Docket No.: 700110076-1
App. Scr. No.: 10/045,418

Telephonic Interview on October 31, 2005

The undersigned thanks the Examiner for the telephonic interview held on October 31, 2005, with a representative for the application, Tiep Nguyen (Reg. No. 44,465), wherein the rejections under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103(a) were discussed.

Regarding the rejection of claim 9 under 35 U.S.C. §112, second paragraph, the Examiner suggested in the telephonic interview that the claim should be amended to read, "a card issuer of the authorization center contacting a communication device by a card issuer of the authorization center."

Regarding the rejection of claims 1-11 under 35 U.S.C. §103(a) as allegedly being unpatentable over Gifford in view of the BCCB book, the Examiner agreed in the telephonic interview that the rejection is not sufficiently clear to enable a meaningful response by the Applicants. For example, it was agreed that the claimed features alleged to be covered by Gifford and by the BCCB book were not clearly discussed in the Office Action. Furthermore, it is not clear which section(s) in 247 pages of the BCCB book allegedly disclose any of the claimed features.

Regarding the rejection of claims 1-3 and 6 under 35 U.S.C. §103(a) as allegedly being unpatentable over Watanabe, the Examiner also agreed in the telephonic interview that the rejection is not sufficiently clear as to enable a meaningful response by the Applicants. For example, the cited section in Watanabe, namely, col. 6, ll. 29+, merely describes the operation of an integrated circuit (IC) card without any details of those features recited in claims 1-3 and 6.

PATENT

Atty Docket No.: 700110076-1
App. Ser. No.: 10/045,418

Claim Rejection under 35 U.S.C. §112, second paragraph

Claims 9 and 10 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claims 9 and 10 have been amended to further conform to the requirements set forth under 35 U.S.C. §112, second paragraph. Particularly, claim 9 has been amended as suggested by the Examiner (as mentioned earlier). Therefore, withdrawal of the rejection of these claims is respectfully requested.

Claim Rejection under 35 U.S.C. 102(b)

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1-3, 5, 7-11 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Niwa (U.S. 6,853,777).

Initially, it is respectfully submitted that Niwa has improperly been applied as a reference under 35 U.S.C. 102(b) against the claimed invention. Niwa does not qualify as a

PATENT

Atty Docket No.: 700110076-1
App. Ser. No.: 10/045,418

reference under 35 U.S.C. 102(b) against the claimed invention because Niwa was published on February 8, 2005, which is well after the filing date of the present application (October 26, 2001). Accordingly, withdrawal of the rejection of claims 1-3, 5, and 7-11 under 35 U.S.C. §102(b) is respectfully requested.

It is also respectfully submitted that the rejection of claims 1-3, 5, and 7-11 is confusing and inconsistent. For instance, the Office Action cited Niwa's sales terminal 21 (FIG. 1) as being in electronic contact with a settlement center to reject the claim language, "*contacting a communication device associated with the account*" in claim 1. Hence, Niwa's sales terminal 21 was cited to reject the claimed "communication device." However, the sales terminal 21 is associated with the sales transaction and not with the account. As such, Niwa discloses that the payee terminal 22, and not the sales terminal 21, is associated with the account. Furthermore, claim 1 recites, "*requesting a transaction confirmation from the communication device.*" In contrast, Niwa discloses requesting a transaction confirmation from the payee terminal 22, and not from the sales terminal 21, whereby the payee terminal 22 provides a password as entered by the user (see Niwa, Abstract and Col. 6, ll. 40+). Even assuming for the sake of argument that Niwa's payee terminal 22 could somehow be reasonably cited as the claimed "communication device," Niwa remains an invalid reference against the claimed invention for at least the following reasons.

Claim 1 recites, "*authorizing the commercial transaction on receiving the approval signal and the transaction confirmation.*" As also recited in claim 1, the approval signal is generated "*upon satisfactory verification*" of the information associated with the account and the "*transaction confirmation*" is requested from the communication device. In contrast, Niwa does not disclose any generation of an approval signal upon a satisfactory verification of the account information that is separate from the "transaction confirmation" as claimed.

PATENT

Atty Docket No.: 700110076-1
App. Ser. No.: 10/045,418

Indeed, verification of account information in Niwa is satisfied as part of the "transaction confirmation" (see Niwa, Col. 6, ll. 40-41).

Regarding claim 5, it is further submitted that Niwa does not disclose a transaction confirmation that is automatically generated by the communication device. Indeed, the Office Action did not mention where such claimed features can be found in Niwa. Therefore, it is respectfully submitted that claim 5 is further allowable over the references of record.

Because Niwa fails to disclose each and every element of claims 1 and 5, withdrawal of the rejection of claim 1 and its dependent claims 2-11 and their allowance over the references of record are respectfully requested.

Claim Rejection under 35 U.S.C. 103(a)

Based upon the Examiner's admission that the various rejections of claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over Gifford, the BCCB book, and Watanabe have not been asserted in a sufficient clear or detailed manner to allow proper responses to such rejections, no responses are provided herein. Accordingly, the Examiner is respectfully requested to either withdraw the rejections of claims 1-11 under 35 U.S.C. §103(a) or provide sufficiently clear rejections to afford Applicants the opportunity to submit proper responses.

Paragraphs 11-14 and 18-20 of the Office Action

The comments contained in paragraphs 11-14 and 18-20 of the Office Action do not appear relevant to the present application. In addition, those comments do not appear to require any response from the Applicants and thus, the Applicants have not responded to those comments.

PATENT

Atty Docket No.: 700110076-1

App. Scr. No.: 10/045,418

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: November 7, 2005

By



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